

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/086,362

(previously of record). Applicant remains of the view that the Examiner is not properly examining the claims.

On their face, the Examiner's rejections are inconsistent. The Examiner cannot fully consider the functional considerations for purposes of the §112 issue and then disregard these same limitations when considering patentability over prior art. To continue the rejections long these lines is not only incorrect, pursuant to MPEP 2143.03, but also unfair to Applicant. Moreover, the Examiner has not responded how the rejections take into account the functional limitations, despite the purported indefiniteness problems. In short, the Examiner has not complied with MPEP 2143.03 in making the prior art rejection.

Claim 1 specifically describes a detector for a leading edge of a photosensitive material and releasing and nipping the material with rollers based on the detector output. For example, the pairs of conveyance rollers release, at least momentarily, after a leading edge has passed through the downstream rollers based on detector output. Kato's disclosed relationship is different. In particular, first and second roller pairs 36, 38 operate in synchronism. Col. 12, lines 2-8. As a trailing edge is detected, a roller becomes released. Col. 16, lines 44-56. By contrast, Applicant's invention specifies release upon a leading edge detection. The Examiner has not adequately rebutted this point.

The Examiner merely relies on the presence of a detector and pairs of rollers in Kato to support the rejection. The Examiner contends that patentability must be determined by structural differences. However, here the structural difference relates to an inter-relationship between a detector and physical nipped and released states of rollers. It is this inter-relationship that is

lacking in Kato. Regardless of any purported problems with the functional recitations of the rollers, the detecting mechanism of the independent claim provides a patentable difference over Kato.

The Examiner's reliance on MPEP 2114 is not appropriate here. The cases discussed in MPEP 2114 relate to unpatentability based on 1) a field of use or 2) inherent disclosure of the claimed operations in the reference. Applicant would submit that neither issue prevents patentability in this case. With regard to the first matter, claimed differences relate to the inter-relationship of a detector and rollers, not a field of use. With regard to the second matter, the claim relationship clearly is not inherent in Kato, which suggests an alternative inter-relationship. The *Hewlett-Packard* case cited by the Examiner also does not prevent patentability in the present situation. In that case, a patent challenger alleged claim invalidity due to similarity in operations of the device. The Federal Circuit indicated that the claims differed from cited art based on how a rough surface was provided. Here, the claims differ from the cited art in terms of how a detector relates to rollers.

Therefore, independent claim 1 is patentable over Kato, and claims 3 and 5 are patentable based on their dependency. Because no prior art rejection remains for claims 2, 4 and 6-10, these claims are also patentable over the prior art.

With regard to the indefiniteness rejection, Applicant would maintain that the Examiner is impermissibly requiring Applicant to claim the preferred embodiment, which is not a requirement of §112. Here, the claims clearly describe a nipping by the rollers in response to a detection relative to a material's leading edge. The claim sets forth sufficient structure and inter-

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relationship as to this recitation. To the extent the Examiner further requires recitation of any cams, motors and means, for example, the features are not needed to describe the fundamental aspects for patentability especially in view of the deficient prior art rejections.

Moreover, the Examiner's reference to "optional language" is not understood, as the Amendment of November 3, 2003 did not introduce such language in the claims. The claims describe roller positioning in response to, or based on, detector output.

In view of the above, Applicant submits that claims 1-21 are in condition for allowance. Therefore it is respectfully requested that the subject application be passed to issue at the earliest possible time. The Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

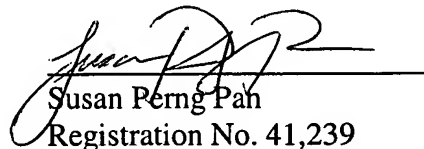
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